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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,278	03/29/2004	Shivakumar Basalingappa Hendi	CO/2-22870/A/CGC 2148	2270

7590 09/27/2005

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EXAMINER

BROWN, JENNINE M

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,278

Applicant(s)

HENDI, SHIVAKUMAR
BASALINGAPPA

Examiner

Jennine M. Brown

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/21/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 6/21/05 was considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 16, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what "a small particle size pigment" would include because most pigments are 10 microns or less in size.

Claims Analysis

Examiner assumes that "effect pigment", "small particle size pigment" and "flop enhancing agent" could all be interchangeable because each are pigments and any three pigments which make up a coating composition would technically meet applicant's required primary limitation.

Examiner notes that Pigment Green 7 is also known as a halogenated copper phthalocyanine.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendi, et al. (US 5618343 A).

Hendi, et al. disclose a pigment composition for coatings, wherein the coating exhibits metallic flop. The flop enhancing agent is disclosed as copper phthalocyanine, indanthrone and carbazole dioxane compounds and derivatives thereof, especially sulfonic acids, sulfonic acid salts, sulfonamide derivatives and alkylamino derivatives thereof (col. 1, l. 64-col. 2, l. 2) wherein particular copper phthalocyanine compounds are given (col. 2, l. 3-39), indanthrone compounds are given (col. 2, l. 40-col. 3, l. 7) and carbazole dioxane compounds are given (col. 3, l. 8-45). The small particle size pigment is disclosed (col. 3, l. 55-64; col. 4, l. 3-col. 6, l. 8) also known as transparent pigments due to their lack of light scattering (col. 3, l. 65-67). Rheology improvement agents are also disclosed (col. 6, l. 18-29). Effect pigments are disclosed as coated and uncoated micas, aluminum flakes and graphite flakes (col. 7, l. 21-23). Texture improvement agents are also disclosed (col. 7, l. 30-40). Methods of making said pigment compositions are also disclosed (col. 7, l. 50-67) as well as methods of making coating compositions (col. 8, l. 1-7). A method of enhancing the flop of a polymeric coating containing an effect pigment and a transparent pigment by incorporating copper phthalocyanine, indanthrone or carbazole dioxazine compounds or mixtures thereof are also disclosed (col. 15, l. 10-col. 16, l. 5). A coating composition comprising an effect pigment, small particle size pigment and flop enhancing agent (col. 6, l. 45-

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col. 7, l. 12; claims 1-10 and 22). A pigment composition comprising a transparent pigment and flop enhancing agent (col. 14, l. 8-col. 15, l. 9). A method of enhancing the flop of a polymeric coating containing an effect pigment and transparent pigment by incorporating a flop enhancing agent into the polymeric coating (claim 21).

Claims 1, 10, 16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Okura, et al. (US 5112403 A).

Okura, et al. disclose a pigment comprising a flop enhancing agent (copper phthalocyanine pigment), small particle size pigment (metal powder pigment) and effect pigment (mica pigment). (col. 4, l. 21-34) which is dispersible in a coating (col. 4, l. 35-55).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of US Patent 5618343 A.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim:

- a coating composition comprising an effect pigment, small particle size pigment (aka transparent pigment) and flop enhancing agent.
- a pigment composition comprising a transparent pigment and flop enhancing agent.
- a method of enhancing the flop of a polymeric coating containing an effect pigment and transparent pigment by incorporating a flop enhancing agent into the polymeric coating.

According to MPEP 2144.09, a prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties." In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (discussed in more detail below) and In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991) (discussed below and in MPEP § 2144) for an extensive review of the case law pertaining to obviousness based on close structural similarity of chemical compounds. See also MPEP § 2144.08, paragraph II.A.4.(c). The structures of the instant claims are such that they are obvious variants of the patented claims and have the same functional utilities. Furthermore although more than

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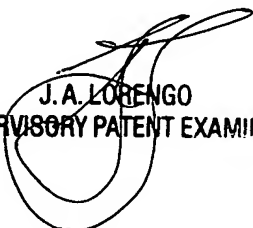
one flop enhancing agent maybe used in the instant claims, it would have been obvious to one of ordinary skill in the art to modify the patented claims to use more than one of each type of pigment to modify the type and amount of flop in the coating.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571) 272-1364. The examiner can normally be reached on M-R 9:30 AM - 7:30 PM; Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmb


J. A. LORENGO
SUPERVISORY PATENT EXAMINER